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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/670,563	09/26/2003	Gerhardt Kumpe	06478.1494	8137
22852	7590	09/06/2006		EXAMINER
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			ROOKE, AGNES BEATA	
			ART UNIT	PAPER NUMBER
			1653	

DATE MAILED: 09/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/670,563	KUMPE ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Agnes B. Rooke	1653	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 01 August 2006.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-13, 15 and 19-24 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-13, 15, 19-24 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application |
|  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 08/01/2006 has been entered.

Claims 1-13 and 15-24 are pending. Claim 14 is cancelled. Claims 1-9 and 16-18 are withdrawn. Claims 10-13, 15 and 19-24 are pending and under examination.

This application claims foreign priority to GERMANY 10246125.2 filed on 10/01/2002.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 10, 15, and 19 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Art Unit: 1653

Claims 10, 15, and 19 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a method of producing a concentrate of VIII:C containing von Willebrand factors comprising subjecting a liquid comprising factor VIII:C and Willebrand factor to fractional precipitation using glycine and NaCl wherein the fractional concentration of glycine is 70-160 g/l and the fractional concentration of NaCl is 100-160 g/l, and does not reasonably provide enablement for all amino acids and all metal salts. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims.

The specification does not enable a person skilled in the art to which it pertains, or with which it is mostly connected, to make or use the invention commensurate in scope with these claims. In *In re Wands*, 8 USPQ2d 1400 (1988), factors to be considered in determining whether a disclosure meets the enablement requirement of 35 U.S.C. 112, first paragraph, have been described. They are: 1) the nature of the invention, 2) the breadth of the claims, 3) the state of the prior art, 4) the predictability or lack thereof in the art, 5) the amount of direction or guidance present, 6) the presence or absence of working examples, 7) the quantity of experimentation needed, and 8) the level of the skill in the art.

1) the nature of the invention: the invention is a process for producing a concentrate of a factor VIII:C containing von Willebrand factor by fractional precipitation using amino acids and metal salt;

2) the breadth of the claims: claims are broad because they claim any amino acid and/or any alkali or alkaline metal salt that can be used in the process; further, more than one of that metals can be used, as referred to it in claims 10 and 19; further in claim 15, the conditions for the stabilization and pasteurization of the concentrate should be provided;

3) the state of the prior art: the prior art discloses a similar method where glycine and NaCl are used in the process; pasteurization process is known, however chemical conditions for the stabilization of the concentrate should be disclosed, since they are specific for the claims at issue;

4) the predictability or unpredictability of the art: claims 10 and 19 state that any amino acid and any alkali or alkaline metal salt (or combination of these) could be used in the method, and therefore, there could be many potential candidates of amino acids or metals, which are used in the method. Thus, the art is unpredictable, since undue experimentation would be necessary to characterize all possible amino acids and the metals claimed; further, the art is unpredictable for claim 15 also, since it would be an undue burden to characterize conditions for stabilization of the concentrate;

5) the amount of direction or guidance present: in Experiment 1, the Applicants describe the use of glycine as an amino acid and NaCl as a salt; the specification conditions for stabilization of the concentrate for claim 15 are also not disclosed;

6) the presence or absence of working examples: the disclosure identifies only glycine and NaCl that are used in the instant method; there are no working examples for the stabilization of the concentrate for claim 15;

7) the quantity of experimentation necessary: there would be an undue experimentation necessary to determine, and characterize all possible amino acids and metal salts that could be used in the method in claims 10 and 19; and there would be an undue experimentation to characterize the stabilization conditions of the concentrate in claim 15;

8) the relative skill of those skilled in the art: the skill in the art is high, since similar method, which uses glycine and NaCl is known in the art.

In consideration of the *In re Wands* factors 1-8, it is apparent that there is undue experimentation necessary because of variability in prediction of the outcome that is not addressed by the present application disclosure, example, teachings, and guidance presented. Absent factual data to the contrary, the amount and level of experimentation needed is undue, rendering claims 10 and 15 subject to the scope of enablement rejection.

Applicants extensively discussed the matter of fractional precipitation methods, see Remarks section pages 7-8; and stated that the scope of claim 10 does not include "all metals salts," and instead recites "an alkali metal and an alkaline earth metal salt; and that the species of amino acids and alkali metal or alkaline earth metal salts can be easily tested to select the conditions that result in an increased content of functional, high molecular weight vWF multimers. Further, Applicants state that stabilization conditions in claim 15 of the product produced during the process with "at least one sucrose, glycine, calcium ions, and albumin" should overcome the enablement rejection.

Examiner respectfully disagrees, and states that an undue experimentation would be required to test all claimed possible alkali and alkaline metals and all amino acids, since experimentation data only provides glycine and sodium salt, and no other experimental data is presented. In addition, the rejected claims refer to at least one of an alkali metal and an alkaline earth metal salt, which implies multiplicity of different metals, other than disclosed sodium, for example. Also, specific teachings regarding stabilization of the concentrate product produced during the claimed process are not pointed out in the specification or defined in the claims, since concentrations or necessary conditions are not provided for sucrose, glycine, calcium ions, or albumin.

Therefore, the rejection of claims 10, 15, and 19 is proper.

Claims 11-13 and 19-24 are included in this rejection because they depend from rejected independent claim 10.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claim 24 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 24, the term "precursor product" must be specifically defined, since the meaning of the term in the claim is not definite. Further, the "precursor" product lacks antecedent basis to claim 15.

**Conclusion**

No claims are allowed.

This action is a continued examination of the instant case, and all rejections previous made are maintained.

Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

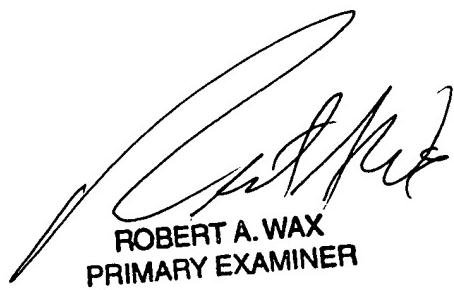
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Agnes Rooke whose telephone number is 571-272-2055. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jon Weber can be reached on 571-273-0925. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status

Art Unit: 1653

information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197.

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A handwritten signature in black ink, appearing to read "ROBERT A. WAX".

ROBERT A. WAX  
PRIMARY EXAMINER